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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/592,462 06/09/00 GRIM

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EXAMINER

QM32/1120

SCOTT R. HANSEN ESQ.

PATTERSON, M

OPPENHEIMER WOLFF & DONNELLY LLP

ART UNIT

PAPER NUMBER

2029 CENTURY PARK EAST

38TH FLOOR

3728

#2

LOS ANGELES CA 90067

DATE MAILED:

11/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/592462

Applicant(s)

Grim et. al.

Examiner

Patterson

Group Art Unit

3728

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-32 is/are pending in the application.
Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 1-23 is/are allowed.
- ☒ Claim(s) 24-32 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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Reissue Applications

1. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: The error stated “The patent claims less than the patentee had the right to claim. For instance, a pad for footgear having removable members with variable density” was claimed in the Patent 5,761,834 in claim 7. Also, it is noted that the newly filed independent claims do not contain this limitations and therefore it is not clear what “error” is being corrected. It appears that the error noted is not an error, since applicant had previously claimed this limitation and has not included this limitation in the independent claims.
2. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: The claims filed herein attempt to broaden the scope of the original patent claims and such a reissue application may not be filed by an assignee per 35 U.S.C. 251 paragraph 3.
3. Claims 24-32 are rejection under 35 U. S. C. 251 thirds paragraph because the claims attempt to broaden the scope of the claims of the original patent and the reissue application was filed by the assignee.
4. Claims 24-32 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984).

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A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In new claims 24 and 32 applicant has removed the limitation of the plurality of sections being arranged in a "grid pattern" which was added in Amendment B filed 12/27/93 in parent application 08/017818 and also argued in application 08/360798 in Amendment C on page 6 and in Amendment D on pages 7 and 8. This limitation was clearly added to all of the independent claims to overcome the art rejections.

New claim 24 is similar to Patented claim 1 except applicant has removed the limitations of "said upper resilient inner sole portion being composed of a plurality of at least 50 separate resilient...", "said sections being directly adjacent one another to form said grid", and "said grid pattern extending over substantially all of said upper inner sole member" these limitations were added and argued in the amendment B in application 08/360798 and argued in amendment B on pages 11 and 12 as added limitations to overcome the prior art.

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Claim Rejections - 35 USC § 112

5. Claims 24-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 24 and 32 the phrases “said sections comprising a relatively softer and more resilient portion for engagement with the foot” and “a relatively less resilient base portion” are confusing, vague, and indefinite because it is not clear what structural limitations applicant intends to encompass with such language. It is not clear in reference to what are the section softer and more resilient than and in reference to what is the base less resilient than.

In claim 32 the phrases “said soft good support” and “the entire sole area” lack antecedent basis rendering the claim vague and indefinite.

In claims 24 and 32 the phrase “less resilient base portion” is confusing, vague, and indefinite because it is not clear what elements in the specification applicant is referring to and therefore it is not clear what structural limitations applicant intends to encompass with such language.

In claim 32 the phrases “in said soft good support”, “over the entire sole area”, and “extending substantially over the entire sole area” are vague and indefinite because they define the pad in reference to undefined and unclaimed elements.

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Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claim 32 is rejected under 35 U.S.C. 102(a or e) as being anticipated by Kellerman (5154682).

Kellerman shows a pad with a flexible sheet (12 or an insert as discussed in column 8 lines 3-8), and removable resilient sections (34) forming an upper resilient layer (depending on which orientation a user desires to use when putting the insert into a shoe) as claimed.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kellerman in view of Andrews (4793078).

Kellerman shows a pad comprising a flexible sheet (12 or an insert as discussed in column 8, lines 3-8) and removable resilient sections (34) forming a resilient layer substantially as claimed except for orienting the insert so that the removable resilient sections are an upper layer.

Andrews teaches orienting an insert with removable resilient sections with the removable sections being the upper layer adjacent a wearer's foot to better relieve pressure at sensitive areas of a wearers foot. It would have been obvious to orient the insert as taught by Andrews in the insert of Kellerman to better relieve pressure at regions of swelling, pain, or inflammation (as discussed in Kellerman in column 6 lines 4-7).

10. Claims 24-26, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grim 5078128) in view of Kellerman and Andrews.

Grim shows a walker with a walker frame (29) with an outer sole (25) and struts (21), a soft goods support (13) secured to the frame, and an inner sole (200) substantially as claimed except for the exact inner sole. Grim suggests the use of customizing the cushion construction in column 3 lines 42-45. Kellerman teaches customizing cushion construction by providing a pad comprising a flexible sheet (12 or an insert as discussed in column 8, lines 3-8) and removable resilient sections (34) forming a resilient layer for relieving pressure at regions of swelling, pain, or inflammation (column 6 lines 4-7). Andrews teaches orienting an insert with removable resilient sections with the removable sections being the upper layer adjacent a wearer's foot to better

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relieve pressure at sensitive areas of a wearers foot. It would have been obvious to provide a pressure relieving insert insole as taught by Kellerman and to orient the insert as taught by Andrews in the walker of Grim to relieve pressure at sensitive areas of a patients foot and thereby customize the cushion for the specific patient.

In reference to claim 25, Grim teaches forming the insole in a symmetrical shape so that it will fit in the symmetrically shaped walker. It would have been obvious to make the insert/insole symmetrically shaped as taught and shown by Grim to allow the insert/insole to fit securely in the walker.

In reference to claim 30, Andrews teaches various “number, shape, and position” (column 2 lines 10-13) for inserts. It would have been obvious to make the inserts any shape including hexagonal or any other shape since Andrews states that such a modification would assist in conforming the insole to “suit the user’s requirements” (column 2 lines 21-22).

11. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 24-26, 30, and 31 above, and further in view of Looney (4408402).

Grim as modified above shows a walker substantially as claimed except for different density sections. Looney teaches making different zones/section (2, 4, and 7-10) with different densities (column 2 lines 40-63). It would have been obvious to provide different density sections as taught by Looney in the footwear of Grim as modified above to provide a more diverse and comfortable insole.

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12. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 24-26, 30, and 31 above, and further in view of Geuder (2913837) or Edelstein (2909854).

Grim as modified above shows a walker substantially as claimed except for a patch over an area of the insole which has a removed insert. Geuder or Edelstein teaches providing a thin patch of material (11 or 3) over an area of an insole which has a hole. It would have been obvious to provide a patch as taught by Geuder or Edelstein in the footwear of Grim as modified above to prevent undesired rubbing movement, to provide a smoother transition, and to prevent the foot from collecting fluid in the portion of the foot which is placed over the removed insert zone.

Allowable Subject Matter

13. Claims 1-23 are allowed.

14. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the Tech Center 3700 **Customer Service Center** number is **(703)306-5648**.


For applicant's convenience, the Group Technological Center FAX number is (703) 305-3580. Please identify Examiner ____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted.

Inquiries concerning the merits of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

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If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Valerie Douglas at (703)308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.


Marie Patterson
Primary Examiner
Art Unit 3728

MDP

November 16, 2000